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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JASON R. THOMPSON, MATTHEW R. LAFONTAINE,
and WILLIAM C. DOWNS

Appeal 2007-2326
Application 10/047,827
Technology Center 3600

Decided: February 20, 2008

Before HUBERT C. LORIN, JENNIFER D. BAHR, and
DAVID B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-40. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm.

Appellants claim accessory-mounting assemblies for mounting accessories at a distance from a base structure such as a body structure of a vehicle (Specification 1:[0001]). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A universal accessory-mounting assembly for supporting an accessory at a distance from a base structure to which the universal accessory mounting assembly may be attached, comprising:
 - (a) three or more support components each of which has a base end and an accessory-support end;
 - (b) wherein each support component has its accessory-support end engaged directly or indirectly to accessory-support ends of every other support component;
 - (c) two or more independent base-attachment structures each of which is engaged to a base end of one of said support components;
 - (d) wherein each of said base-attachment structures comprises means for securing it to the base structure;
 - (e) wherein one or more of said base-attachment structures are each biaxially pivotally engaged to said base end of a respective one of said support component(s) by a ball-and-socket joint;
 - (f) accessory-attachment structure to which the accessory may be mounted; and
 - (g) wherein said accessory-attachment structure is engaged directly or indirectly to and/or comprises one or more of said accessory-support ends of said support components.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Murgas	US 3,395,883	Aug. 6, 1968
Rawlinson	US 5,100,093	Mar. 31, 1992

Claims 1-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Murgas in view of Rawlinson. Claims 1-40 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Appellants' Admitted Prior Art in view of Rawlinson.

ISSUE

The issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 1-40 as unpatentable over Murgas in view of Rawlinson and alternately over Appellants' Admitted Prior Art in view of Rawlinson. The dispositive issue is whether it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify one or more of the base-attachment structures of Murgas or the Appellants' Admitted Prior Art to biaxially pivotally engage them to the base end of each support component by a ball-and-socket joint.

Rather than repeat the arguments of Appellant and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007).

FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. There is no dispute that Murgas and Appellants' Admitted Prior Art disclose all of the limitations of claim 1 except that one or more of said base-attachment structures are each biaxially pivotally engaged to said base end of a respective one of said support component(s) by a ball-and-socket joint (Answer 3-4 and 6-7).
2. Rawlinson teaches a mirror attachment assembly that uses a multi-axis pivoting arrangement that adapts to a wide variety of windshield shapes (Rawlinson, abstract). Rawlinson teaches multiple embodiments in which ball-and-sockets are used to connect base-attachment structures to support components (See, e.g., Rawlinson, col. 5, l. 36 – col. 6, l. 19, and figures 6-10).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the

prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

ANALYSIS

A. Rejection of claims 1, 3-18, and 20-40 under 35 U.S.C. § 103(a) as unpatentable over Murgas or AAPA in view of Rawlinson.

The Examiner found that neither Murgas nor the Appellants’ Admitted Prior Art (Specification; Figure 3; pp. 1-3) discloses the base attachment structures being biaxially pivotally engaged to the base end of each support component by a ball-and-socket joint (Answer 4 and 7). The Examiner found that Rawlinson teaches a universal accessory mounting assembly wherein the base-attachment structures are biaxially pivotally engaged to the base end of each support component by a ball-and-socket

joint (Answer 4, citing Rawlinson, figure 5; column 5, lines 4-35). The Examiner found that it would have been obvious to one skilled in the art at the time that the invention was made to modify the base-attachment structures of Murgas or the Appellants' Admitted Prior Art such that they were biaxially pivotally engaged to the base end of each support component by a ball-and-socket joint as claimed in view of the teachings of Rawlinson so as to make the assembly adaptable to vehicles with different base structure designs (Answer 5 and 7; respectively citing Rawlinson; col. 5; ll. 24-27).

The Appellants argue that Rawlinson does not supply a teaching which supports the proposed modification of using ball and socket joints in an assembly having three points of support (Br. 6). The Appellants argue that Rawlinson teaches a mirror mounting arrangement using various types of pivoting joints, including ball-and-socket joints in ““a multi-axis pivot that adapts to a wide variety of windshield shapes, *and* that permits pivoting the mirror down and out of the way when not in use.”” (Br. 7, citing Rawlinson, col. 2, ll. 4-7, emphasis in Brief). Appellants further argue that Rawlinson appears strictly limited to a situation where exactly two points of support are used (Br. 8, 15). It appears that Appellants are arguing that using ball and socket joints with three supports would prevent pivoting the structure down and out of the way when not in use, a function which is not claimed.

This argument is not persuasive because the Examiner relies on Rawlinson only for the teaching of a universal accessory mounting assembly wherein the base-attachment structures are biaxially pivotally engaged to the base end of each support component by a ball-and-socket joint (Answer 4).

Further, Appellants' argument appears to attack Rawlinson individually, rather than the combination of Murgas or Appellants' Admitted Prior Art with Rawlinson proposed by the Examiner. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Moreover, Appellants appear to be arguing that in the absence of a specific teaching of the use of ball and socket joints in a three joint arrangement, it would not have been obvious to do so. To the extent the Appellants argue in their pre-*KSR* Brief that there is no explicit teaching, suggestion, or motivation to combine Rawlinson with Murgas or Appellants' Admitted Prior Art, that argument is foreclosed by *KSR*. *KSR*, 127 S.Ct. at 1740-41 ("the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.")

In *KSR*, the Supreme Court emphasized that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious

unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

In this case, attaching the base attachment structures of Murgas or Appellants’ Admitted Prior Art to the base end of each support component using the ball-and-socket joints of Rawlinson is no more than the combination of familiar elements according to known methods, which is likely to be obvious where, as here, it does no more than yield predictable results. *KSR*, 127 S.Ct. at 1734.

Neither Appellants’ Specification nor Appellants’ arguments present any evidence that addition of the ball-and-socket joint of Rawlinson to the support structures of Murgas or Appellants’ Admitted Prior Art as suggested by the Examiner is uniquely challenging or difficult for one of ordinary skill in the art. Under these circumstances, the Examiner did not err in holding that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the base-attachment structures of Murgas or the Appellants’ Admitted Prior Art such that they were biaxially pivotally engaged to the base end of each support component by a ball-and-socket joint as claimed in view of the teachings of Rawlinson so as to make the assembly adaptable to vehicles with different base structure designs (Answer 5 and 7). Because this is a case where the improvement is no more than the predictable use of prior art elements according to their established functions, no further analysis was required by the Examiner. *KSR*, 127 S.Ct. at 1740.

The Appellants have failed to show error in the Examiner’s rejection of claim 1. Claims 3-18 and 20-40 were not argued separately, and fall with

claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007). *See also In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

B. Rejection of claims 2 and 19 under 35 U.S.C. § 103(a) as unpatentable over Murgas or AAPA in view of Rawlinson.

Claims 2 and 19 require that “one or less of said base-attachment structures are engaged to a base end of a support component in a manner other than being biaxially pivotally engaged through a ball-and-socket joint.” “One or less” includes the case where none of the base-attachment structures are connected other than via a ball-and-socket joint; i.e., all connections are made via ball-and socket joints. Appellants argue that the prior art uniformly illustrates connection of the legs of an accessory support and its respective vehicle using either all fixed or pivotable connectors, and the fact that the invention on appeal may be achieved using a mixed set of joints highlights its distinctiveness (Br. 16). The Appellants’ argument is not persuasive, since the actual claim language reads on an all pivotable arrangement. The Appellants have failed to show error in the Examiner’s rejection of claims 2 and 19.

CONCLUSIONS

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-40 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1-40 under 35 U.S.C. § 103(a) is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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